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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,591	08/26/2003	Sanford D. Markowitz	CWRU-P03-003	4997

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FISH & NEAVE IP GROUP  
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ONE INTERNATIONAL PLACE  
BOSTON, MA 02110-2624

EXAMINER

RAWLINGS, STEPHEN L

ART UNIT	PAPER NUMBER
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1643

MAIL DATE	DELIVERY MODE
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03/20/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

**Application No.**

10/649,591

**Applicant(s)**

MARKOWITZ, SANFORD D.

**Examiner**

Stephen L. Rawlings, Ph.D.

**Art Unit**

1643

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 16 February 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: 75,84-91,93,95-97,101,102 and 104-106.  
Claim(s) rejected: 98-100 and 103.  
Claim(s) withdrawn from consideration: 94 and 123.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.


**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

  
Stephen L. Rawlings, Ph.D.  
Primary Examiner  
Art Unit 1643

Continuation of 3. NOTE: The proposed amendment will not be entered because, if it were, it would raise new issues, which would require further consideration and/or search. For example, the amendment would add claim 125, which is directed to a method for determining whether a subject is likely to have a relapse of colon cancer or a persistent or progressive colon cancer. Inasmuch as the invention of claim 125 is patentably distinct from the elected invention (i.e., the invention of Group I, claims 75-107, drawn to a method for detecting colon neoplasia in a subject, said method comprising detecting the presence of one or more polypeptides in a sample acquired from the subject, wherein said one or more polypeptides is a polypeptide comprising an amino acid sequence that is at least 95% identical to SEQ ID NO: 3), entry of the amendment would require an explanation as to why the subject matter of claim 125 is properly withdrawn as directed to the subject matter of a non-elected invention. In addition, because entry of the amendment would otherwise have remedied the issues remaining, but for the claim objections, it would have been then necessary, upon entry of the amendment, to consider the non-elected species of the invention of Group I, namely wherein wherein said one or more polypeptides is a polypeptide comprising an amino acid sequence that is at least 95% identical to SEQ ID NO: 3), entry of the amendment would require an explanation as to why the subject matter of claim 125 is properly withdrawn as directed to the subject matter of a non-elected invention. In addition, because entry of the amendment would otherwise have remedied the issues remaining, but for the claim objections, it would have been then necessary, upon entry of the amendment, to consider the non-elected species of the invention of Group I, namely wherein said one or more polypeptides is a secreted polypeptide produced by the expression of a nucleic acid having the sequence of SEQ ID No: 5. Notably, because the claims would be directed to a genus of polypeptides produced by the expression of a nucleic acid having the sequence of SEQ ID NO: 5, where the only species described with any particularity is the polypeptide of SEQ ID NO: 3, entry of the amendment would raise new issues under 35 U.S.C. § 112, first paragraph, both in terms of the written description and enablement provisions set forth there under. Finally, entry of the amendment would require a determination of whether or not the invention is free of the prior art, a determination that cannot be made without further search. Accordingly, the amendment is not deemed to place this application in better form for appeal by materially reducing or simplifying the issues for appeal.

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's request is predicated upon entry of the proposed amendment; however, because the amendment has not been entered, Applicant's request is presently moot.

  
STEPHEN RAWLINGS